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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BRODA, SAMUEL

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/632,803	Applicant(s) RAPPAPORT ET AL.	
	Examiner Samuel Broda	Art Unit 2123	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/18/03</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This communication is in response to Applicants' Amendment Under 37 C.F.R. § 1.111 (the "Amendment") received on 6 December 2004. Claims 33, 36, 40, 52, 55, and 59 were amended; claims 74-77 were added; claims 33-77 are pending.

Drawings

2. Applicants' amended drawings are accepted. Formal drawings incorporating these drawing amendments will be required when the application is allowed.

Specification

3. The disclosure is objected to because of the following informalities:

3.1 The attempt to incorporate subject matter into this Application by reference to U. S. Patent Numbers 6,317,599, 6,442,507, 6,493,679, and 6,499,006 is improper because the Application:

- (1) does not appear to contain "essential material" which describes the claimed invention and provides an enabling disclosure; and
- (2) attempts to incorporate subject matter from other applications which themselves incorporate "essential matter" by reference.

See MPEP § 608.01(p).

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For example, at page 23 of the Specification the disclosure corresponding to the limitation of the “computerized model which represents a physical environment” appears to disclosed in Application 09/318,841, and the disclosure corresponding to limitation of the “prediction model[s]” appears to be disclosed in Application 09/221,985. The remainder of the Specification fails to adequately disclose each limitation of claim 33 but instead points to other applications.

Additionally, with reference to the limitation of:

one or more prediction models which use the computerized model and the performance attributes of specific components of said plurality of system components to predict performance characteristics of said communications network,

the Specification appears to describe implementations of the prediction model(s) with reference to the “SitePlanner ®” prediction engine, but the Specification contains no details describing how predictions are made. For example, page 34 lines 5-30 of the Specification states (emphasis added):

As an example, network system performance results might be computed to create a prediction run for predicted signal-to-noise ratio (SNR) for a wireless inbuilding system throughout a building. If the models used in the prediction engine were sufficiently accurate, then such a process would eliminate the need for measurement runs in order to install a properly functioning system. **In the prediction engine contemplated by SitePlanner ®, which is disclosed in part in all of the cross referenced co-pending applications listed above, various performance parameters which provide electrical, mechanical, numerical, or**

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physical descriptions of the modeled communication system **must** be provided. These performance parameters may include the addition, removal, replacement, re-connection, re-orientation, or some other modification of one or more attributes which describe one or more of the effects that are required for accurate simulation performance of the prediction engine. Some examples of such inputs might include: physical locations of transmitters, antennas, RF distribution lines, connectors, splitters, base station controllers, switches, optical-to-RF couplers; cable losses, splitter losses; antenna patterns; power levels of the transmitters; gains of the amplifiers, and frequencies to be simulated, must be applied to the input of the prediction engine. While the list in the preceding sentence is not meant to be exhaustive, **it demonstrates the level of detail and interconnectivity dependencies that are considered to properly model the transmission system, both physically and electrically, as it would actually be installed in a real building. This is because of the visualization capabilities of the invention which focuses on illustrating the network as it really appears in true life. . . .**

Claim Rejections - 35 U.S.C. § 112, First Paragraph

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4.1 Claims 33-77 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

4.2 Regarding independent claims 33 and 52, each independent claim includes the limitation “one or more prediction models which use the computerized model and the performance attributes of specific components of said plurality of system components to predict performance characteristics of said communications network.”

As described above, while the Specification appears to describe the importance of providing input data to the SitePlanner ® prediction engine, the Specification does not appear to disclose how one skilled in the art would make and use the prediction models. According to the Specification, this description is deferred to other co-pending applications.

4.3 All claims dependent from either claim 33 or claim 52 inherit this defect and are rejected.

Applicants' Arguments

5.1 Applicants first argue at page 20 of the Amendment that the Specification, via Figures 10-12, provides the essential subject matter required to support the amended claims.

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5.2 Applicants also argue at page 20 of the Amendment that the claim amendments overcome the rejections under Section 112, first and second paragraph.

Examiner's Reply

6. The Examiner respectfully disagrees for the following reasons:

6.1 Regarding the adequacy of the Specification to contain essential matter, the Examiner disagrees for the reasons stated above in Section 3. Applicants' reference to Figs. 10-12 do not disclose how to make and/or use the "computerized model" or the "prediction model[s]".

6.2 Regarding Applicants' arguments that the amended claims overcome the prior Section 112 rejections, the Examiner agrees. However, the amended claims still do not appear to be adequately disclosed by the Specification, as described above in Sections 3 and 4.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to Applicants' disclosure.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Samuel Broda, whose telephone number is (703) 305-1026. The Examiner can normally be reached on Mondays through Fridays from 8:00 AM – 4:30 PM.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kevin Teska, can be reached at (703) 305-9704. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist, whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'S. Broda'.

**SAMUEL BRODA, ESQ.
PRIMARY EXAMINER**